



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

ARENT FOX KINTNER PLOTKIN & KAHN, PLLC
SUITE 400
1050 CONNECTICUT AVENUE, N.W.
WASHINGTON DC 20036-5339

COPY MAILED

MAR 17 2008

OFFICE OF PETITIONS

In re Application of
Melvin S. Mogil
Application Number: 10/642211
Filing or 371(c) Date: 08/18/2003
Attorney Docket Number: 100570-00036

DECISION DISMISSING PETITION
UNDER 37 CFR 1.78(a)(3)

This is a decision on the petition under 37 CFR 1.78(a)(3), filed on January 18, 2008, to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of priority to the prior-filed nonprovisional applications listed in the subject petition.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000 and after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

Where an application claims a benefit under 35 U.S.C. 120 of a chain of applications, the application must make a reference to the first (earliest) application and every intermediate application. See Sampson v. Ampex Corp., 463 F.2d 1042, 1044-45, 174 USPQ 417, 418-19 (2d Cir. 1972); Sticker Indus. Supply Corp. v. Blaw-Knox Co., 405 F.2d 90, 93, 160 USPQ 177, 179 (7th Cir. 1968); Hovlid v. Asari, 305 F.2d 747, 751, 134 USPQ 162, 165 (9th Cir. 1962). See

also MPEP 201.11. In addition, every intermediate application must also make a reference to the first (earliest) application and every application after the first application and before such intermediate application. MPEP 201.06(d).

Petitioners should review the claim for priority to ensure that a reference is made to the first application and to every intermediate application. In this regard, a review of Office PALM records indicates that Application No. 09/323,202, filed on June 1, 1999, which issued as U.S. Patent No. 6,234,677, does not contain a claim to the benefit of prior-filed Application No. 29/113,102. Since U.S. Patent No. 6,234,677 issued from Application No. 09/323,202, filed on June 1, 1999, which was prior to November 29, 2000, no petition under 37 CFR 1.78 is required to be filed in Application No. 09/323,202, to add the benefit claim. However, the benefit claim must be corrected by way of a certificate of correction filed in U.S. Patent No. 6,234,677.

Additionally, the amendment states that the subject application, No. 10/642,211, is a continuation of Application No. 29/113,102. Application No. 29/113,102, however, issued as U.S. Patent No. D425,342 on December 26, 2000, prior to the filing of the subject application on August 18, 2003. Accordingly, Application No. 29/113,102 was not copending with Application No. 10/642,211, and Application No. 10/642,211 may not claim the benefit of prior-filed Application No. 29/113,102. Petitioner must remove the aforementioned improper benefit claim prior to filing any renewed petition.

Further in this regard, petitioner may wish to consider adding a claim of benefit to Application No. 29/113,102 in Application No. 09/323,202, as Application No. 09/323,202, which was filed on June 1, 1999, and issued on May 22, 2001, was copending with Application No. 29/113,102. As stated above, no petition under 37 CFR 1.78 is required to be filed in Application No. 09/323,202 to add a benefit claim because Application No. 09/323,202 was filed on June 1, 1999, which was prior to November 29, 2000. Since Application No. 29/113,102 is a design application, however, the only permissible benefit claim which could be made to Application No. 29/113,102 in utility Application No. 09/323,202 is that Application No. 09/323,202 is a continuation-in-part of Application No. 29/113,102.

Additionally, while the amendment filed with the present petition states that Application No. 09/881,770 is a continuation of prior-filed Application No. 09/453,502, a review of Office PALM records for Application No. 09/881,770, indicates that Application No. 09/881,770 is a divisional, rather than a continuation, of the prior-filed application. No petition under 37 CFR 1.78 is required to be filed to correct the relationship in the prior-filed applications, but a certificate of correction must be filed in U.S. Patent No. 6,644,063, which issued from Application No. 09/881,502, correcting the relationship to the prior-filed application.

Alternatively, if an amendment was filed in Application No. 09/881,770 to correct the relationship referenced above prior to the issuance of Application No. 09/881,770 as U.S. Patent No. 6,644,063, petitioners should so state in any renewed petition. A copy of that amendment should accompany any renewed petition.

Upon the granting of Certificate(s) of Correction addressing the above matters, petitioners may file a renewed petition in the subject application. A copy of the Certificate(s) of Correction should accompany the renewed petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: Customer Service Window
Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: (571) 273-8300
ATTN: Office of Petitions

Any questions concerning this matter may be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.



Anthony Knight
Supervisor
Office of Petitions